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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,500	04/21/2004	John D. Robinson	AST-0001	4294
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RADER FISHMAN & GRAUER PLLC			EXAMINER	
LION BUILDING			EL CHANTI, HUSSEIN A	
1233 20TH STREET N.W., SUITE 501			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/828,500	ROBINSON, JOHN D.	
	Examiner Hussein A. El-chanti	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
  - 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 15-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/5/05
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to application filed on April 21, 2004. Claims 1-23 are pending examination.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to computer network monitoring, classified in class 709, subclass 224.
- II. Claims 15-23, drawn to multi-computer data transferring, classified in class 709, subclass 213.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as "retrieving an approved subject line phrase corresponding to a particular user and parsing the email message to determine whether the email has an approved subject line phrase. Subcombination II has a separate utility such as downloading an email from a server and restoring the email to the server in response to a request". See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the

allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Christopher Tobin on Sep. 25, 2007, a provisional election was made without traverse to prosecute the invention of group II, claims 15-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 15, 18 and 21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15, 18 and 21 recite the limitation "as though it had not been downloaded" in line 9. The claim does not define "it". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 15-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Beyda et al., U.S. Patent No. 6,275,850 (referred to hereafter as Beyda).

As to claim 15, Beyda teaches a method for restoring electronic mail messages to a mail server, the method comprising:

determining that an electronic mail message addressed to a particular user is resident at a mail server (see col. 6 lines 63-col. 7 lines 60, an email is received at the server addressed to a client);

receiving the electronic mail message at a mail client from the mail server pursuant to an electronic mail downloading procedure that entails deleting the electronic mail message from the mail server (see col. 6 lines 7-60 and col. 8 lines 27-34, the

email is sent to the receiver based on a determination with respect to a plurality of rules);

receiving a request to restore the electronic mail message on the mail server following a completion of the electronic mail downloading procedure (see col. 8 lines 8 lines 40-47, the original message is sent back to the server in response to a forward request); and

restoring the electronic mail message as though it had not been downloaded from the mail server in response to receiving the request (see col. 8 lines 45-55, the copy of the received email is sent to the server).

As to claim 16, Beyda teaches the method of claim 15, further comprising:

determining whether the electronic mail message is an appropriate candidate for restoration prior to restoring the electronic mail message (see col. 8 lines 35-40, a determination is made as to whether there is a modification to the attachment and in response to the determination, a copy of the message is sent to the server).

As to claim 17, Beyda teaches the method of claim 15, wherein restoring the electronic mail message comprises:

creating a temporary message file that includes a re-written header and an original message body corresponding to the electronic mail message, wherein the re-written header indicates that the message is being sent from the original sender of the electronic mail message and to the particular user; and transmitting the temporary message file to the mail server (see col. 8 lines 48-61, the email with the same content is transmitted back to the server).

As to claim 18, Beyda teaches a computer program product for restoring electronic mail messages to a mail server, the computer program product stored on a computer readable medium and adapted to perform operations comprising:

determining that an electronic mail message addressed to a particular user is resident at a mail server (see col. 6 lines 63-col. 7 lines 60, an email is received at the server addressed to a client);

receiving the electronic mail message at a mail client from the mail server pursuant to an electronic mail downloading procedure that entails deleting the electronic mail message from the mail server (see col. 6 lines 7-60 and col. 8 lines 27-34, the email is sent to the receiver based on a determination with respect to a plurality of rules);

receiving a request to restore the electronic mail message on the mail server following a completion of the electronic mail downloading procedure (see col. 8 lines 8 lines 40-47, the original message is sent back to the server in response to a forward request); and

restoring the electronic mail message as though it had not been downloaded from the mail server in response to receiving the request (see col. 8 lines 45-55, the copy of the received email is sent to the server).

As to claim 19, Beyda teaches the computer program product of claim 18, wherein the operations further comprise:

determining whether the electronic mail message is an appropriate candidate for restoration prior to restoring the electronic mail message (see col. 8 lines 35-40, a

determination is made as to whether there is a modification to the attachment and in response to the determination, a copy of the message is sent to the server).

As to claim 20, Beyda teaches the computer program product of claim 18, wherein restoring the electronic mail message comprises:

creating a temporary message file that includes a re-written header and an original message body corresponding to the electronic mail message, wherein the re-written header indicates that the message is being sent from the original sender of the electronic mail message and to the particular user; and transmitting the temporary message file to the mail server (see col. 8 lines 48-61, the email with the same content is transmitted back to the server).

As to claim 21, Beyda teaches a system for restoring electronic mail messages to a mail server, the system comprising:

a e-mail management module, which determines that an electronic mail message addressed to a particular user is resident at a mail server (see col. 6 lines 63-col. 7 lines 60, an email is received at the server addressed to a client);

an e-mail restoration module, in communication with the e-mail management module, which receives a request to restore the electronic mail message on the mail server following a completion of the electronic mail downloading procedure (see col. 8 lines 8 lines 40-47, the original message is sent back to the server in response to a forward request); and

restores the electronic mail message as though it had not been downloaded from the mail server in response to receiving the request (see col. 8 lines 45-55, the copy of the received email is sent to the server).

As to claim 22, Beyda teaches the system of claim 21, wherein the e-mail restoration manager determines whether the electronic mail message is an appropriate candidate for restoration prior to restoring the electronic mail message (see col. 8 lines 35-40, a determination is made as to whether there is a modification to the attachment and in response to the determination, a copy of the message is sent to the server).

As to claim 23, Beyda teaches the system of claim 21, wherein the e-mail restoration manager restores the electronic mail message by creating a temporary message file that includes a re-written header and an original message body corresponding to the electronic mail message, wherein the re-written header indicates that the message is being sent from the original sender of the electronic mail message and to the particular user, and transmitting the temporary message file to the mail server (see col. 8 lines 48-61, the email with the same content is transmitted back to the server).

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hussein Elchanti/